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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,300	02/08/2001	Peter Kwasny	KWASNY-2	4557

7590 05/20/2002

COLLARD & ROE, P.C.
1077 Northern Boulevard
Roslyn, NY 11576

EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 05/20/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

MFAS

Office Action Summary	Application No.		Applicant(s)	
	09/779,300		KWASNY, PETER	
	Examiner		Art Unit	
	Judy M. Reddick		1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/01/02 & 04/01/02.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Information Disclosure Statement

1. **The information disclosure statement filed 04/01/02 has been considered and placed in the application file.**

Claim Rejections - 35 USC § 112

2. **The following is a quotation of the second paragraph of 35 U.S.C. 112:**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

A) **The recited "at least one HS (high solid) acrylic resin --- and with a high solids content" per claim 1, "at least one MS (medium solid) acrylic resin--- and having a medium solids content" per claim 4 and "at least one LS (low solid) acrylic resin --- and having a low solids content" per claim 6 constitutes indefinite subject matter as per said phrases contain redundant subject matter.**

B) **The recited "wherein said paint material has no styrene and an OH-number" per claim 1, "characterized in that the paint material has a number average molecular weight" per claim 2, "said paint material having a low content of styrene and an OH-number" per claim 4, "wherein the paint material has a number average molecular weight" per claim 5 and "higher styrene content" per claim 6 constitutes indefinite subject matter as per a) it not being readily ascertainable, in each instance, if the paint material or the acrylic resin is being qualified especially since the recited molecular weights could only govern the**

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acrylic resin and not the paint material. Further the metes and bounds of "low content of styrene" and "higher styrene content" engender an indeterminacy in scope.

C) The recited "number mean molecular weight" and "number average molecular weight" per claim 1 constitutes indefinite subject matter as per it not being readily ascertainable as to why different methods of measurement were used in determining the molecular weight for the acrylic resin(s).

D) The recited "and united only immediately prior/before to their processing" per claims 1, 4 and 6 engenders confusing and awkwardly expressed claim language. It is suggested that applicant adopt the following language: "and combined only immediately before their application".

E) The recited "amounts to" per claims 1, 4 and 6 engenders awkwardly expressed claim language. It is suggested that applicant adopt the following language: wherein the weight ratio range of the paint material and hardener to propellant is 75:25 to 70:30.

F) The recited "comprising of a propane/butane mixture" per claim 4 engenders a grammatical deficiency. It is suggested that applicant adopt the following language: "comprising a mixture of propane and butane" or "comprising a propane/butane mixture".

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application

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was filed, had possession of the claimed invention. As far as the examiner can readily ascertain, no support can be found for the recited "number mean molecular weight" per claim 1 and "number average molecular weight" per claims 1, 2, 5 and 6 and this, as such, without any concrete guidelines from applicant as to where support might be found, engenders a New Matter situation.

Allowable Subject Matter

6. *After further consideration coupled with an extensive review of the application, the rejection based on Gormley et al is herein withdrawn. One having ordinary skill in the art would not have been endowed with any motivation to extrapolate from Gormley et al or any of the prior art of record, an aerosol preparation comprising an acrylic resin-containing paint material, a hardener and a propellant, wherein said paint material and hardener are filled in two different containers within a spray can and combined only prior to their application, with any reasonable expectation of success.*

7. *The claims would be allowable if rewritten and/or amended so as to obviate the 112 issues raised supra. Applicant is cautioned that if "number" prefacing the "mean" and "average" molecular weights is cancelled, the 112, 2nd paragraph rejection based on the type of molecular weight intended will be reinstated.*

Response to Arguments

8. *Applicant's arguments filed 03/01/02 have been fully considered but they are not persuasive.*

*Relative to the 112, 2nd paragraph issues---**While Counsel, in a good faith effort attempted to remedy the 112 issues raised in the previous Office Action(poaper*

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no. 2, 12/03/01), some issues remain and new 112 issues were discovered and/or created. Relative to the recited "low" and "higher", there is absolutely nothing concrete on this record diffusing this issue.

The arguments relative to Gormley et al are deemed moot since the rejection based on patentee has been dropped.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

J. M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR *JMR*
May 16, 2002